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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,761	03/26/2001	Franz Laermer	10191/1629	5642
26646	7590	06/07/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			CHEN, KIN CHAN	
			ART UNIT	PAPER NUMBER

1765

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

09/720,761

Applicant(s)

LAERMER ET AL.

Examiner

Kin-Chan Chen

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

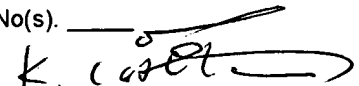
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 34-36 and 40.
Claim(s) objected to: _____.
Claim(s) rejected: 19, 21-24, 27-33 and 39.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


Kin-Chan Chen
Primary Examiner
Art Unit: 1765

Response to Request-for-reconsideration-after-final

1. The examiner notes that applicant has corrected numerous editorial (typographic) errors in claims 21,22,24, 31, 33,35,and 36 in the current list of claims.

Applicant is required to review and correct all numerous editorial (typographic) errors. For examples, in clam 19, line 8 and claim 24, line 10, "IF_s" should be -IF₅-. In claim 27, "C0₂" should be--CO₂--. In claim 32, "N₂0" should be --N₂O—and "C0₂" should be--CO₂--.

2. Applicant has argued that Kawasaki teaches using C₄F₈ for etching aluminum rather than polysilicon (one kind of silicon substrate). It is not persuasive. Kawasaki teaches that polysilicon may be etched using C₄F₈ (see claims 10 and 19). Applicant argued that Kawasaki does not teach that C₄F₈ forms passivating layer. It is not persuasive. Because the same material is used with the same plasma etching process, it is expected that the method of the combined prior art would contain the same properties and product as claimed (forming a passivating layer).

3. Applicant has argued that Kawasaki does not teach using helium (so-called light, ionizable gas), and uses 2MHz during the etch for different reason. It is not persuasive. As has been stated in the office action, in the method of etching silicon substrate, Meyer teaches that helium may be used in the process of etching silicon substrate (col. 2, lines 65-68). Hence, it would have been obvious to one with ordinary skill in the art to incorporate helium as taught by Meyer in the process of the combined prior art in order to ensure the stability and promotes uniformity of the etching. As such, the properties

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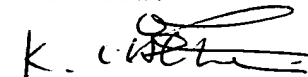
and effect of the light, ionized gas (e.g., improve selectivity, reduce charging effects, increase separation) recited in the claimed invention would have been expected because the same materials are used with the same process.

The discovery of a new property of a previously known composition, even if unobvious from the prior art, cannot impart patentability to such a composition. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Once a reference teaching product (composition) appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence of reasoning to show inherency, the burden shifts to the applicant to show an unobvious difference. Whether the rejection is based on "inherency" under 35 U.S.C. §102, or on "prima facie obviousness" under 35 U.S.C. §103, jointly or alternatively. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). See also In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

In light of comments above, the rejections are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kin-Chan Chen whose telephone number is (571) 272-1461. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


Kin-Chan Chen
Primary Examiner
Art Unit 1765

June 2, 2006